

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-23 are presently pending in this case. Claims 1, 15, and 17 are amended and new Claims 21-23 are added by the present amendment. As amended Claims 1, 15, and 17 and new Claims 12-23 are supported by the original disclosure,¹ no new matter is added.

In the outstanding Official Action, Claims 15 and 16 were rejected under 35 U.S.C. §112, first paragraph; Claims 1-3, 15, and 17-19 were rejected under 35 U.S.C. §103(a) as unpatentable over Yanagihara (U.S. Patent No. 5,835,668) in view of Lane (U.S. Patent No. 5,793,927) and further in view of Temple et al. (U.S. Patent No. 7,386,218, hereinafter “Temple”); Claim 8 was rejected under 35 U.S.C. §103(a) as unpatentable over Yanagihara in view of Lane and Temple and further in view of Acharya et al. (U.S. Patent Application Publication No. 20030194008, hereinafter “Acharya”); and Claims 9 and 16 were rejected under 35 U.S.C. §103(a) as unpatentable over Yanagihara in view of Lane and Temple and further in view of Mimura (Japanese Patent Application Publication No. 08-031044) and Deangelo (U.S. Patent Application Publication No. 2006010136). However, Claims 4-7, 10-14, and 20 were objected to as being dependent on a rejected base claim, but otherwise were indicated as including allowable subject matter if re-written in independent form.

Applicants gratefully acknowledge the indication that Claims 4-7, 10-14, and 20 include allowable subject matter.

With regard to the rejection of Claims 15 and 16 under 35 U.S.C. §112, first paragraph, paragraph 24 of the publication of the specification describes that one aspect of the invention includes a computer program. As noted in MPEP §2163, “The examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of

¹See, e.g., the publication of the specification at paragraphs 156-169.

presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims.” As the outstanding Office Action concedes at page 2 that one of ordinary skill in the art would clearly understand that a computer program is stored on a “computer readable medium,” this phrase is clearly supported at least by paragraph 24 the specification. Accordingly, Claims 15 and 16 are in compliance with all requirements under 35 U.S.C. §112, first paragraph.

With regard to the rejection of Claims 1, 15, and 17 as unpatentable over Yanagihara in view of Lane and Temple, that rejection is respectfully traversed.

Amended Claim 1 recites in part:

setting means for setting, on the basis of said content data time information checked by said checking means, bit rates with which said content data is recorded from said information processing apparatus to a predetermined removable recording medium, *the setting means selecting the bit rates such that an amount of data to be stored on the predetermined removable recording medium is less than a capacity of a predetermined removable recording medium based on a comparison between a resulting amount of data for selected bit rates and the capacity of a predetermined removable recording medium.*

Yanagihara describes a method for transmitting digital data. The outstanding Office Action cited column 5, lines 7-15 and column 7, lines 7-33 as describing “setting means” as originally recited in Claim 1.² However, Yanagihara does not appear to describe any means for selecting bit rates *such that an amount of data to be stored on the predetermined removable recording medium is less than a capacity of a predetermined removable recording medium*. In particular, Yanagihara does not appear to describe any comparison between a resulting amount of data for selected bit rates and the capacity of a predetermined removable recording medium. Thus, Yanagihara does not teach or suggest “setting means” as recited in amended Claim 1. Moreover, it is further respectfully submitted that Lane and

²See the outstanding Office Action at page 3.

Temple do not teach or suggest this feature either. Consequently, as the proposed accommodation does not teach or suggest “setting means” as recited in amended Claim 1, Claim 1 (and Claims 2-14 and 22 dependent therefrom) is patentable over Yanagihara in view of Lane and Temple.

Amended Claim 15 recites in part “setting, on the basis of said content data time information checked by said checking, bit rates with which said content data is recorded from said information processing apparatus to a predetermined removable recording medium, *the setting including selecting the bit rates such that an amount of data to be stored on the predetermined removable recording medium is less than a capacity of a predetermined removable recording medium based on a comparison between a resulting amount of data for selected bit rates and the capacity of a predetermined removable recording medium.*”

As noted above, Yanagihara does not describe selecting bit rates *such that an amount of data to be stored on the predetermined removable recording medium is less than a capacity of a predetermined removable recording medium.* In particular, Yanagihara does not appear to describe any comparison between a resulting amount of data for selected bit rates and the capacity of a predetermined removable recording medium. Therefore, Yanagihara does not appear to describe “setting” as defined in amended Claim 15. Further, it is respectfully submitted Lane and Temple do not teach or suggest features either. Consequently, Claim 15 (and Claims 16 and 23 dependent therefrom) is also patentable over Yanagihara in view of Lane and Temple.

Amended Claim 17 recites in part “a setting unit configured to set bit rates with which said content data is recorded from said information processing apparatus to a predetermined removable recording medium on the basis of said content data time information checked by said checking unit, *the setting unit configured to select the bit rates such that an amount of data to be stored on the predetermined removable recording medium is less than a capacity*

of a predetermined removable recording medium based on a comparison between a resulting amount of data for selected bit rates and the capacity of a predetermined removable recording medium.” As noted above, Yanagihara does not describe any device configured to select bit rates *such that an amount of data to be stored on the predetermined removable recording medium is less than a capacity of a predetermined removable recording medium.* In particular, Yanagihara does not appear to describe any comparison between a resulting amount of data for selected bit rates and the capacity of a predetermined removable recording medium. Thus, it is respectfully submitted that Yanagihara does not teach or suggest “a setting unit” as defined in amended Claim 17. Finally, it is respectfully submitted Lane and Temple do not teach or suggest these features either. Consequently, amended Claim 17 (and Claims 18-21 dependent therefrom) is patentable over Yanagihara in view of Lane and Temple.

With regard to the rejection of Claim 8 as unpatentable over Yanagihara in view of Lane and Temple and further in view of Acharya, it is noted that Claim 8 is dependent from Claim 1, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Acharya does not cure any of the above-noted deficiencies of Yanagihara, Lane, and Temple. Accordingly, it is respectfully submitted that Claim 8 is patentable over Yanagihara in view of Lane and Temple and further in view of Acharya.

With regard to the rejection of Claim 9 and 16 as unpatentable over Yanagihara in view of Lane and Temple and further in view of Mimura and Deangelo, it is noted that Claims 9 and 16 are dependent from Claims 1 and 15, respectively, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Mimura and Deangelo do not cure any of the above-noted deficiencies of Yanagihara, Lane, and Temple. Accordingly, it is respectfully submitted that Claim 9 and 16 are

Application No. 10/522,752
Reply to Office Action of September 15, 2009

patentable over Yanagihara in view of Lane and Temple and further in view of Mimura and Deangelo.

Finally, new Claims 21-23 are supported at least by the original specification at paragraphs 168-170. As new Claims 21-23 dependent from Claims 1, 15, and 17, new Claim 21-23 are allowable for at least the reasons described above with respect to those claims. Further, new Claims 21-23 recites subject manner which further defines over the cited references. Accordingly, new Claims 21-23 are also allowable.

Accordingly, the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)

Edward W. Tracy, Jr.
Registration No. 47,998